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EXAMINER

VAN DOREN, BETH

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/545,381

Applicant(s)

SPIELMANN ET AL. 

Examiner

Beth Van Doren

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Final Office Action in response to communications received 06/10/2004. Claims 2-6, 8-14, 16, and 17 have been amended. Claims 1-18 are pending in this application.

Claim Objections

2. Claims 1, 10, and 14 are objected to because they each contain the limitation “the control procedured identified by an administrator” which should more appropriately be -- the control procedures identified by an administrator--. Correction is required in each instance.

3. Claim 10 is also objected to because it contains steps a.-c., d., d., e.-i. (i.e. two step d.’s are recited). Claim 10 should more appropriately recite steps a.-j. Correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 3623

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Higgins et al. (U.S. 6,397,202).

5. As per claim 1, Higgins et al. teaches a method of managing risk with the aid of a computer system, said method comprising:

- a. the computer receiving a user selection of risk elements, said risk elements being retrieved from a database coupled to said computer (See at least figure 1, column 3, lines 30-45, column 4, lines 50-67, column 5, lines 1-15 and 27-50, wherein the user selects and manipulates risk elements stored in the database of the computer);
- b. for each risk element, the computer retrieving one or more predetermined control procedures, the control procedures identified by an administrator as a means for mitigating said risk element by reducing the likelihood that the risk will occur (See at least column 3, lines 27-45 and 57-67, column 4, lines 1-7 and 40-60, column 5, lines 1-15, column 6, lines 40-60, and column 7, lines 1-27, wherein control procedures that are programmed into the system by an expert and are related to the risk factor are identified, these control procedures being means to reduce the likelihood that a risk will occur);
- c. the computer associating said one or more predetermined control procedures with said risk element, said predetermined control procedures being stored in said database (See at least column 3, lines 27-45 and 57-67, column 4, lines 1-7 and 40-60, column 5, lines 1-15, column 6, lines 40-60, and column 7, lines 1-27, wherein the input risk elements are related to the control procedures);

Art Unit: 3623

- d. the computer retrieving a weight assigned to each one of said predetermined control procedures, said weight being stored in said database (See at least column 3, lines 55-60, column 4, lines 1-7, column 5, lines 5-20, and column 7, lines 1-20, which discusses weighting the control procedures);
 - e. the computer receiving a user selection of a compliance rating for each said predetermined control procedure, the rating selected by the user indicating a level of compliance with each one of said predetermined control procedures (See at least column 3, lines 25-42 and 55-67, column 5, lines 4-20 and 45-60, column 6, lines 9-40, wherein the computer receives inputs from a user that rate the level of compliance of the elements with the control procedure); and
 - f. the computer calculating a compliance score, each compliance score being a function of said assigned weights and said compliance rating of said predetermined control procedures (See at least figures 2 and 3 and column 3, lines 35-60, column 4, lines 1-15 and 42-67, column 5, lines 5-15, and column 7, lines 1-9 and 15-27, wherein the computer uses the expert system to calculate a score which is a function of the weights and ratings supplied).
6. As per claim 2, Higgins et al. teaches a method wherein said compliance ratings comprise at least one rating identifying a non-fully compliant control procedure, said method further comprising the steps of:
- a. for each said control procedure having a non-fully compliant rating, the computer receiving a user generated signal indicating whether said non-fully compliant control procedure is accepted or not accepted (See at least column 4, lines 1-15 and 65-67, column 5, lines 1-10, column 6, lines 1-25 and 60-67,

Art Unit: 3623

wherein the user generates a signal indicating that certain control procedures have unacceptable compliance ratings); and

b. for each of said non-fully compliant control procedure which is indicated as not accepted, requiring the user to provide signals for generating an action plan (See at least column 4, lines 1-15 and 65-67, column 5, lines 1-10, column 6, lines 1-25 and 60-67, wherein the user generates a signal changing inputs and weights previously associated with a control procedures to create a new plan for measurement).

7. As per claim 3, Higgins et al. teaches a method wherein said action plan includes a target date, said method further comprising the step of the computer calculating an expected compliance score for one or more future dates based on said action plan target dates (See at least figures 2 and 3 and column 3, lines 35-60, column 4, lines 1-15 and 42-67, column 5, lines 5-15 and 30-55 and column 7, lines 1-9 and 15-27, wherein the computer uses the expert system to calculate a score for a future date which is a function of weights, ratings, and dates).

8. As per claim 4, Higgins et al. discloses a method further comprising the step of the computer tracking whether said expected compliance scores have been met, said tracking including calculating actual compliance scores for said target dates (See at least figures 2 and 3, column 1, lines 15-20, column 3, lines 30-65, column 5, lines 35-55, column 6, lines 60-67, wherein actual versus predicted are monitored).

9. As per claim 5, Higgins et al. discloses a method further comprising the step of the computer displaying said expected compliance scores versus said actual compliance for the target dates (See figure 2 and column 5, lines 25-57, that teaches such a display).

Art Unit: 3623

10. As per claim 6, Higgins et al. teaches a method further comprising the step of the computer associating one or more parameters with each said compliance rating (See at least column 3, lines 25-42 and 55-67, column 5, lines 4-20 and 45-60, column 6, lines 9-40, wherein the compliance rating is associated with parameters).

11. As per claim 7, Higgins et al. teaches a method wherein said one or more parameters are selected from the group comprising organization, business line, process, and region (See column 3, lines 55-60, column 6, lines 10-40, which disclose organization parameters like staffing).

12. As per claim 8, Higgins et al. teaches a method further comprising the step of the computer sorting said compliance scores by said one or more parameters (See at least figure 3, column 3, lines 30-60, column 4, lines 44-60, column 5, lines 15-22 and 40-67, column 6, lines 1-20, wherein values are input and stored and organized according to the parameter of risk to which the values are associated).

13. As per claim 9, Higgins et al. discloses a method further comprising the step of the computer displaying said sorted compliance scores (See at least figures 2 and 3 and column 3, lines 30-55, which discloses a visual output).

14. As per claim 10, Higgins et al. teaches a method of managing risk with the aid of a computer system, said method comprising:

- a. the computer receiving a user selection of risk elements, said risk elements being retrieved from a database coupled to said computer (See at least figure 1, column 3, lines 30-45, column 4, lines 50-67, column 5, lines 1-15 and 27-50, wherein the user selects and manipulates risk elements stored in the database such as schedule risk);

Art Unit: 3623

- b. the computer identifying one or more subrisk elements associated with each said risk elements, each subrisk element being retrieved from said database (See at least figure 1, column 3, lines 30-60, column 4, lines 1-15 and 50-67, column 5, lines 1-15 and 27-50, and column 6, lines 1-17, 20-35, and 49-54, wherein the subrisk elements are associated with the risk, such as staffing levels being associated with schedule risk);
- c. for at least one subrisk element, the computer retrieving one or more predetermined control procedures, the control procedures identified by an administrator as a means for mitigating said risk element by reducing the likelihood that risk will occur (See at least column 3, lines 27-45 and 57-67, column 4, lines 1-7 and 40-60, column 5, lines 1-15, column 6, lines 40-60, and column 7, lines 1-27, wherein the input risk elements are related to the control procedures);
- d. the computer associating said one or more control procedures with said risk element, said control procedures being stored in said database (See at least column 3, lines 27-45 and 57-67, column 4, lines 1-7 and 40-60, column 5, lines 1-15, column 6, lines 40-60, and column 7, lines 1-27);
- e. the computer retrieving a weight assigned to each one of said predetermined control procedures, said weight being stored in said database (See at least column 3, lines 55-60, column 4, lines 1-7, column 5, lines 5-20, and column 7, lines 1-20, which discusses weighting the control procedures);
- f. the computer receiving a user selection of a compliance rating for each said predetermined control procedure, said compliance ratings including a

Art Unit: 3623

plurality of categories including at least one category indicating said control procedure is not fully compliant (See at least column 3, lines 25-42 and 55-67, column 5, lines 4-20 and 45-60, column 6, lines 9-40, wherein the computer receives inputs from a user that rate the level of compliance of the elements with the control procedure);

g. the computer calculating a compliance score, said compliance score being a function of said assigned weights and said compliance rating of said control procedures (See at least figures 2 and 3 and column 3, lines 35-60, column 4, lines 1-15 and 42-67, column 5, lines 5-15, and column 7, lines 1-9 and 15-27, wherein the computer uses the expert system to calculate a score which is a function of the weights and ratings supplied);

h. for each subrisk, the computer determining whether at least one control procedure associated with said subrisk is not fully compliant (See at least column 4, lines 1-15 and 65-67, column 5, lines 1-10, column 6, lines 1-25 and 60-67, wherein the user generates the computer indicates that a subrisk is not compliant);

i. for each subrisk associated with at least one control procedure which is not fully compliant, the computer receiving a signal from the user indicating whether said subrisk should be accepted or not accepted (See at least column 4, lines 1-15 and 65-67, column 5, lines 1-10, column 6, lines 1-25 and 60-67, wherein the user generates a signal indicating that certain control procedures have unacceptable compliance ratings); and

j. for each subrisk which is indicated as not accepted, the computer generating an action plan (See at least column 4, lines 1-15 and 65-67, column 5,

Art Unit: 3623

lines 1-10, column 6, lines 1-25 and 60-67, wherein the user generates a signal changing inputs and weights previously associated with a control procedures to create a new plan for measurement).

15. As per claim 11, Higgins et al. teaches a method wherein said action plan further includes a target date, said method further comprising the step of the computer calculating a future compliance score based on said action plan target dates (See at least figures 2 and 3 and column 3, lines 35-60, column 4, lines 1-15 and 42-67, column 5, lines 5-15 and 30-55 and column 7, lines 1-9 and 15-27, wherein the computer uses the expert system to calculate a score for a future date which is a function of dates).
16. As per claims 12 and 13, claim 12 and 13 contain equivalent limitations to claims 6 and 8, respectively, and are therefore rejected using the art and rationale relied upon in the rejection of claims 6 and 8, respectively.
17. As per claim 14, Higgins et al. teaches a method of forecasting risk with the aid of a computer system, said method comprising:
- a. the computer identifying a set of risk elements, said risk elements being stored in a database coupled to said computer (See at least figure 1, column 3, lines 30-45, column 4, lines 50-67, column 5, lines 1-15 and 27-50, wherein the user selects and manipulates risk elements stored in the database of the computer);
 - b. for at least one risk element, the computer retrieving one or more predetermined control procedures, the control procedures identified by an administrator as a means for mitigating said risk element by reducing the likelihood the risk will occur (See at least column 3, lines 27-45 and 57-67, column 4, lines 1-7 and 40-60, column 5, lines 1-15, column 6, lines 40-60, and

Art Unit: 3623

column 7, lines 1-27, wherein control procedures that are programmed into the system by an expert and are related to the risk factor are identified, these control procedures being means to reduce the likelihood that a risk will occur);

c. the computer associating said one or more control procedures with said risk element, said control procedures being stored in said database (See at least column 3, lines 27-45 and 57-67, column 4, lines 1-7 and 40-60, column 5, lines 1-15, column 6, lines 40-60, and column 7, lines 1-27, wherein the input risk elements are related to the control procedures);

d. the computer retrieving a weight assigned to each one of said predetermined control procedures, said weight being stored in said database (See at least column 3, lines 55-60, column 4, lines 1-7, column 5, lines 5-20, and column 7, lines 1-20, which discusses weighting the control procedures);

e. the computer receiving a user selection of a compliance rating for each said predetermined control procedure, said compliance rating chosen from a set of ratings including at least one rating identifying a non-fully compliant control procedure and at least one rating identifying fully compliant control procedures (See at least column 3, lines 25-42 and 55-67, column 5, lines 4-20 and 45-60, column 6, lines 9-40, wherein the computer receives inputs from a user that rate the level of compliance of the elements with the control procedure);

f. for each said control procedure having a non-fully compliant rating, the user employing the computer to generate an action plan, said action plan including a target date for at least one action listed therein (See at least column 4, lines 1-15 and 65-67, column 5, lines 1-10, column 6, lines 1-25 and 60-67,

Art Unit: 3623

wherein the user generates a signal changing inputs and weights previously associated with a control procedures to create a new plan for measurement); and

g. the computer calculating an expected compliance score for a future date, said expected compliance score being a function of said assigned weights, said fully compliant control procedures, and said action plan target dates for said non-fully compliant control procedures (See at least figures 2 and 3 and column 3, lines 35-60, column 4, lines 1-15 and 42-67, column 5, lines 5-15 and 30-55 and column 7, lines 1-9 and 15-27, wherein the computer uses the expert system to calculate a score for a future date which is a function of weights, ratings, and dates).

18. As per claim 15, Higgins et al. teaches a method wherein said action plan comprises a signal indicating whether said non-fully compliant rating is accepted or not accepted, said expected compliance score further being a function of said non-fully compliant ratings which have been accepted. (See at least column 4, lines 1-15 and 65-67, column 5, lines 1-10, column 6, lines 1-25 and 60-67, wherein the user generates a signal indicating that certain control procedures have unacceptable compliance ratings).

18. As per claim 16, Higgins et al. teaches a data processing system for managing risk, said system comprising

- a. a database (See at least figure 1, column 3, lines 30-45, column 4, lines 50-67, column 5, lines 1-15 and 27-50, wherein a database is disclosed);
- b. a processor coupled to said database, said processor being programmed to perform the steps comprising (See at least figure 1, column 4, lines 40-60, column 5, lines 35-55):

- i. the computer receiving a first signal identifying a user selection of a set of risk elements, said risk elements being stored in said database (See at least figure 1, column 3, lines 30-45, column 4, lines 50-67, column 5, lines 1-15 and 27-50, wherein the user selects and manipulates risk elements stored in the database of the computer);
- ii. the computer receiving a second signal identifying a user selection of one or more control procedures associated with each said risk element, said control procedure comprising a means to mitigate said risk element, said control procedure being stored in said database (See at least column 3, lines 27-45 and 57-67, column 4, lines 1-7 and 40-60, column 5, lines 1-15, column 6, lines 40-60, and column 7, lines 1-27, wherein control procedures that are programmed into the system by an expert and are related to the risk factor are identified, these control procedures being means to reduce the likelihood that a risk will occur);
- iii. the computer receiving a third signal assigning a weight to each said control procedure, said weight being stored in said database (See at least column 3, lines 55-60, column 4, lines 1-7, column 5, lines 5-20, and column 7, lines 1-20, discussing weighting the control procedures); and
- v. the computer calculating a compliance score, said compliance score being a function of said assigned weights and said compliance rating of said control procedures (See at least figures 2 and 3 and column 3, lines 35-60, column 4, lines 1-15 and 42-67, column 5, lines 5-15 and 30-55

and column 7, lines 1-9 and 15-27, wherein the computer uses the expert system to calculate a score which is a function of weights and ratings).

19. As per claim 17, Higgins et al. teaches a data processing system wherein said compliance ratings comprise at least one rating identifying a non-fully compliant control procedure, said processor being further programmed to perform the steps comprising:

- a. for each said control procedure having a non-fully compliant rating, the computer receiving a signal indicating whether said non-fully compliant rating is accepted or not accepted (See at least column 4, lines 1-15 and 65-67, column 5, lines 1-10, column 6, lines 1-25 and 60-67, wherein the user generates a signal indicating that certain control procedures have unacceptable compliance ratings);
- b. for each said non-fully compliant control procedure which is indicated as not accepted, the computer receiving an action plan, said action plan including an expected target date for implementation and an expected compliance rating (See at least column 4, lines 1-15 and 65-67, column 5, lines 1-10, column 6, lines 1-25 and 60-67, wherein the user generates a signal changing inputs and weights previously associated with a control procedures to create a new plan for measurement); and
- c. the computer generating one or more future expected compliance scores, said compliance scores being a function of said target dates, said assigned weights, and said expected compliance rating of said control procedures (See at least column 5, lines 25-55, and column 7, lines 20-30, wherein future scores are determined).

Art Unit: 3623

20. As per claim 18, Higgins et al. teaches a data processing system further comprising a computer display coupled to said processor, said processor further being programmed to display said compliance scores on a computer display (See at least figures 2 and 3 and column 3, lines 30-55, which discloses a visual output).

Response to Arguments

21. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new grounds of rejection, as necessitated by amendment.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (703) 305-3882. The examiner can normally be reached on M-F, 8:30-5:00.

Art Unit: 3623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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September 3, 2004



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